

*Applicant: Roberto A. Gaxiola*  
*Serial No. 09/934,088*

Fig. 1A illustrates that the two AVP-1 plant types (AVP1-1 and AVP1-2) were significantly hardier in salty soil as compared to wild-type plants.

Applicants have moved the sentence describing Fig. 5 to the end of the paragraph for purposes of clarity only and have substituted "drawing" in place of "perspective view". While the word "drawing" was not used originally, it is believed that this substitution does not change the substance of the description and is a better description term of the figure, which on examination is a drawing. "Perspective" is confusing and not a fair description.

Fig. 3 has been replaced with "Fig. 1A". Fig. 3 clearly is not described by the text of section [0068]. The text corresponds to Fig. 1A, as found in the specification under the brief description of the drawings.

[0072]: Fig. 4 is clearly intended to show blot data and in order to maintain consistency, applicants have substituted "immunoblots" from the figure description. In [0072], line 6, amendment is made to delete (Fig. 1) and substitute (Fig. 4); to delete "Western blots" and substitute "immunoblots".

The following amendments have been made in order to conform the text in these paragraphs to the figure descriptions.

[0073]: line 5, replace "2C" with "6C".

[0074]: line 1, replace "6" with "6A and Fig. 6B".

[0076]: line 1: replace "is" with "are".

[0077]: line 6: replace "8" with "7".

[0080]: line 3: replace "1" with "9".

[0081]: lines 5-6, replace "2A and 2B" with "10A and 10B"; line 10, replace "2A and 2B" with "10A and 10B".

[0083]: line 6 on page 22, add "See Fig. 11."

### **Objections to the Claims:**

Claims 40, 58, 71 and 73 have been objected to for improper dependent form in failing to limit subject matter of preceding claim. Claim 58 lacks an article before "exogenous" and claims 71 and 73 contain misspelling of "Ncotinia".

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Applicants have corrected the informalities in claim 58. The other claims have been canceled and it is believed that the objection is now moot.

**Double Patenting Rejections:**

Claims 38,43-44,49-51,55,56,57 and 77-78 have been provisionally rejected under a double patenting rejection over co-pending application 09/834,998. In essence, the Action takes the position that the broader claims inherently subsume the salt-tolerant plants claimed in the '998 application, despite applicants claims to plant resistance to any externally imposed stress.

Applicants respectfully request deferment of a response to a double patenting rejection until such time as the '998 patent issues or prosecution of the instant application is otherwise complete.

Claims 33-45, 47-57, 68-69 and 75-79 have also been provisionally rejected under a double patenting rejection over co-pending application 09/834,998 as not patentably distinct from claims in the '998 copending application.

Applicants respectfully request deferment of a response to a double patenting rejection until such time as the '998 patent issues or prosecution of the instant application is otherwise complete.

Claims 33-45, 47-48, 51-57, 68-69 and 75-79 have been provisionally rejected under a double patenting rejection over co-pending application 09/834,998 as not patentably distinct from claims in the '998 copending application.

Applicants respectfully request deferment of a response to a double patenting rejection until such time as the '998 patent issues or prosecution of the instant application is otherwise complete.

Claims 33-45, 47-48, 51-57, 68-69 and 75-79 have been provisionally rejected under a double patenting rejection over co-pending application 09/834,998 as not patentably distinct from claims in the '998 copending application as encompassing the same products.

Applicants respectfully request deferment of a response to a double patenting rejection until such time as the '998 patent issues or prosecution of the instant application is otherwise complete.

**Rejection of claims 35,36,45,47,48,53,58-76,59,68,69,75 and 76 under 35 U.S.C. §112, second paragraph**

Claims 35,36,45,47,48,53,58-76,59,68,69,75 and 76 have been rejected under 35 U.S.C. 112, second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

In claims 35 and 36, the description of temperatures below 0°C is considered unclear. Claims 35-36 have been amended. Claims 47, 48, 53, 59-65, 68-69 and 71-76 have been canceled. Pending claims have been amended to more clearly define the transgenic plant and claim 58 has been amended to more clearly indicate that increased seed production is in the transgenic plant.

**Rejection of claims 33-45, 47-57 under 35 U.S.C. §112, first paragraph**

Claims 33-45 and 47-57 stand rejected under 35 U.S.C. §112, first paragraph as lacking enablement for stresses other than water deficit and increased NaCl concentrations. It is believed that the claims as now presented described the particular stresses to which the transgenic plant is less susceptible by comparison with its wild-type counterparts. The amendments and new claims are also directed to plants that harbor a particular type of transgene, demonstrated in *Arabidopsis* and tobacco, but also in such plants as tomato, corn, tobacco, rice, sorghum, cucumber, lettuce, turf grass, ornamental and legume plants as described on page 11, section [0052] of the application. Applicants believe they have defined the transgenic plants as described and supported in the specification.

**Rejection of claims 33-45, 47-57, 68, 69 and 75-79 under 35 U.S.C. §102(e)**

Claims 33-45, 47-57, 68, 69 and 75-79 stand rejected under 35 U.S.C. 102(e) as anticipated by the Gaxiola, et al. publication (2002/0178464). The publication is cited as teaching the same transgenic plants, seeds and progeny as in the present application.

Applicants respectfully direct attention to the date of filing of applicant's provisional application filed in 2000. In the event that the 2002 published application does not issue, applicants believe it can be used under §102(e) only as of the effective date of publication. Applicant respectfully requests deferral of a response to this rejection until such time as the published application matures into a patent and/or other issues with the present application have been resolved.

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**Conclusion:**

Applicants submit that the claims are in condition for allowance and such action is earnestly solicited.

A petition to extend the period for replying for three months to and including March 24, 2004 and a check for the required fee under 37 C.F.R. §1.17(a) are enclosed. Should the fee be deficient for any reason, the Commissioner is authorized to charge the deficiency to Edwards & Angell Deposit Account No. 04-1105.

Reconsideration of the application is respectfully requested.

Respectfully submitted,

  
Barbara S. Kitchell, Registration No. 33,928  
Attorney for Applicant  
EDWARDS & ANGELL, LLP  
P.O. Box 55874  
Boston, MA 02205  
(203) 353-6848

Customer No.: 21874